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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,063	10/17/2001	Kazuhisa Kashiwazaki	0234-0433P	4184

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EXAMINER

COMBS, JANELL A

ART UNIT	PAPER NUMBER
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1742

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DATE MAILED: 04/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-5

Office Action Summary	Application No.	Applicant(s)	
	09/978,063	KASHIWAZAKI ET AL.	
	Examiner	Art Unit	
	Janelle Combs-Morillo	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/462744.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 58-031054 (JP'054).

JP'054 teaches an aluminum alloy of composition comprising (in weight%): 2.3-3.5% Si, 0.4-1% Mg, 0.05-0.5% Zn, 0.4-0.9% Mn, up to 0.3% Cu, up to 0.20% Cr, up to 0.1% Ti, up to 0.3% Fe (see abstract and Table on page 290), which overlaps the composition as presently claimed. Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP § 2112.01, *In re Best* 195 USPQ 430, *In re Malagari*, 182 USPQ 549, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Because of the overlap, JP'054 is held to create a prima facie case of obviousness of the presently claimed invention.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-110232.

JP 10-110232 teaches an aluminum alloy of composition comprising (in weight%): 0.2-3% Si and 0.2-3% Mg, one or more of: 0.01-0.5% Mn, 0.01-0.5% Cr, 0.01-0.5% Zr, 0.001-0.5% Ti, and one or more of: 0-2.5% Cu and 0-2% Zn, and up to 1%, which overlaps the composition as presently claimed (see abstract). Because of the overlap in composition ranges, JP'232 is held to create a prima facie case of obviousness of the presently claimed invention.

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4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-256095 (JP'095).

JP'095 teaches an aluminum alloy sheet of composition comprising (in weight%): 0.8-3.5% Si, 0.6-1.4% Mn, 0.1-1% Fe, 0.1-0.5% Cu, up to 0.6% Mg, up to 2.0% Zn, and optionally one or more of Ti, Cr, and Zr (abstract, Table on page 3) which overlaps or touches the boundary of the composition as presently claimed. Because of the overlap in composition ranges, it is held that JP 09-256095 has created a prima facie case of obviousness of the presently claimed invention.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 58-031054 in view of Komatsubara et al.

JP'054 teaches substantially the same process steps as presently claimed including the conventional steps of casting, homogenizing, hot rolling, and cold rolling (abstract). JP'054 does not teach the use of recycled aluminum scrap. However, Komatsubara et al teaches that it is conventional in the art to produce similar Al-Si-Mg sheets from scrap material. It would have been obvious to one of ordinary skill in the art to combine the teachings of Komatsubara et al and JP'054, that is, to make Al-Si-Mg sheets of the composition as taught by JP'054 with recycled scrap, as taught by Komatsubara et al, because Komatsubara et al teaches it is common to make Al-Si-Mg alloy sheets out of recycled scrap.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09256095 or JP 10-110232 as applied to claim 1 above, and further in view of Komatsubara et al.

In the translated parts, JP 09256095 and JP 10-110232 do not teach the presently claimed process steps of casting, homogenizing, hot rolling, and cold rolling. The examiner asserts that it

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is notoriously well-known in the art of producing Al-Si-Mg plates, to perform the steps of casting, homogenizing, hot rolling, and cold rolling, substantially as presently claimed. JP'095 and JP'232 do not teach the use of recycled aluminum scrap. Komatsubara et al teaches that it is conventional in the art to produce similar Al-Si-Mg sheets from scrap material (column 8 lines 33-38). It would have been obvious to one of ordinary skill in the art to combine the teachings of Komatsubara et al and JP'095 or JP'232, that is, to make Al-Si-Mg sheets of the composition as taught by JP'095 or JP'232 with recycled scrap, as taught by Komatsubara et al, because Komatsubara et al teaches it is common to make Al-Si-Mg alloy sheets out of recycled scrap.

Provisional Double Patenting

Copending Application No. 09/331,966

7. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 10-15 of copending Application No. 09/331,966. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 09/331,966 teach an overlapping Al-Mg-Si alloy composition, as well as the use of recycled materials in said Al-Mg-Si alloy product. The composition taught by claim 10 of 09/331,966 comprises: 2.6-4% Si, 0.3-1.5% Mg, 0.1-1.5% Fe, 0.2-1.2% Cu, 0.3-1.2% Zn, and at least one of 0.01-0.3% Mn, 0.01-0.3% Cr, 0.01-0.3% Zr, 0.01-0.3% V, which substantially overlaps the presently claimed composition ranges.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Copending Application No. 09/644,830

8. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5 and 8 of copending Application No. 09/644830. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 09/644830 teach an overlapping Al-Mg-Si alloy composition, as well as the use of recycled materials in said Al-Mg-Si alloy product. The composition taught by claim 1 of 09/331,966 comprises: 1.5-5% Si, 0.2-1.5% Mg, 0.2-1.2% Fe, 0.2-2% Cu, less than 2% Zn, 0.05-1% Mn, and at least one of 0.1% or less Cr, 0.25% or less Zr, 0.1% or less Ti, which substantially overlaps the presently claimed composition ranges. Claims 2 of copending Application No. 09/644830 teaches the alloy can be made from recycling aluminum materials, and claim 8 teaches said alloy can be made into automotive members.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Copending Application No. 09/738,048

9. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/738,048. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 09/738,048 teaches substantially the same composition as presently claimed, said composition comprising 2.6-5% Si, 0.15-0.3% Mg, 0.05-1% Mn, 0.2-1.5% Fe, 0.3-2% Cu, 0.2-2.5% Zn, 0.005-0.05% Ti, 0.005-0.1% Cr.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

US Pat. 6,325,870 B1

10. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,325,870 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 4 of U.S. Patent No. 6,325,870 teach substantially the same Al-Mg-Si alloy composition as presently claimed, said composition comprising 3.5-5% Si, 0.3-0.8% Mg, 0.6-1.0% Mn, 0.4-1.5% each of Fe, Cu, and Zn, 0.01-0.2% of one or more of Ti, Cr, Zr, and V.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (703) 308-4757. The examiner can normally be reached on 7:30 am- 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7719 for regular communications and (703) 305-7719 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER


jcm
April 4, 2002